REMARKS

The specification and claims 1, 2, 4, and 8-14 have been amended for clarification purposes only, and do not present new matter or warrant a new search. No claims have been canceled or added. Thus, claims 1-20 are currently pending in the case. Further examination and reconsideration of the presently claimed application are hereby respectfully requested.

Section 101 Rejections

Claims 8-14 were rejected under 35 U.S.C. § 101 for the claimed computer program being directed to non-statutory subject matter. In response thereto, the preamble of claims 8-14 have been amended to claim a "computer-usable carrier medium comprising a computer program," where the "computer-usable carrier medium" may comprise any number of computer hardware components directly or indirectly disclosed in the Specification or commonly known in the art (e.g., various processors, buses, interface units, storage devices/structures, peripheral devices, among others). As noted in MPEP 2106.IV.B(1)(a), "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory." A computer-usable carrier medium is considered to encompass computer-readable mediums (e.g., storage devices), in addition to other computer hardware components. Regardless of the particular structure to which it is associated, recitation of the presently claimed computer program in conjunction with a physical structure converts the once non-statutory subject matter of claims 8-14 to statutory. Accordingly, removal of the this rejection is respectfully requested.

Section 112 Rejections

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, claims 1, 2, and 4 were rejected for failing to provide sufficient antecedent basis for certain terms contained within those claims. To expedite prosecution, claims 1, 2, and 4 have been amended to clarify the claim language. Accordingly, removal of this rejection is respectfully requested.

Section 102 Rejections

Claims 1-4, 8, 9, 12, and 14-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,438,746 to Martin (hereinafter "Martin"). The standard for "anticipation" is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Martin does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

Martin does not disclose a method for generating computer executable code, where the method includes creating a data set by modifying a comments portion of a program. Independent claim 1 states in part: "[a] method for generating computer executable code, comprising: creating a data set by modifying a comments portion of a program ..." Martin discloses a "compiler is provided for a distributed object system in which functional requirements on system performance criteria can be entered as comment fields in an object-oriented language" (Martin, Abstract). Martin, however, does not disclose a method for generating computer executable code, where the method includes creating a data set by modifying a comments portion of a program, as recited in present claim 1.

Statements in the Office Action suggest that Martin does provide teaching for "creating a data set (1000b) by modifying (col. 5, lines 51-60) a comments portion (see Fig. 9) of a program" (Office Action, page 3). The Applicant respectfully disagrees for at least the reasons set forth in more detail below.

In the passage cited by the Examiner, Martin describes how a user may decide to edit the source code of program if errors occur during execution of the source code. In particular, Martin states, "[i]f the [edited] source code appears satisfactory ... the pre-compiler 316 is applied to the source code in the source code store 308 to generate amended code, which is then compiled in a step 216 by the C++ compiler to generate executable code in the executable code store 310." *See*, Martin, column 5, lines 51-60, emphasis added. However, editing or modifying program source code, as taught by Martin, is not equivalent to creating a data set by modifying a comments portion of the program, as taught in present claim 1. Though Martin mentions the existence of a comments portion (e.g., portion 1000b) in FIG. 9, Martin does not mention that the comments portion can be modified to create a data set. Instead, Martin merely discloses that the comments portion may be "interpreted" by pre-compiler 316 for generating new

source code to be added to the original source code. *See*, e.g., Martin, column 7, line 34 to column 8, line 63. Interpreting a comments portion of a program cannot be considered equivalent to modifying the comments portion. Consequently, Martin fails to anticipate all limitations of present claim 1.

Martin does not disclose a data set that changes dependent on modification of a link within a comments portion of a computer program. Independent claim 8 (a computer-usable carrier medium) recites a limitation on a computer program comprising a data set that changes dependent on modification of a link, which succeeds a first text (i.e., a comment) that is preceded by a comments designator. Independent claim 15 (an apparatus) recites a limitation on a compiler for generating a data set containing at least one field of bits in response to user-activation of a link within a comments portion of a computer program.

As noted above, Martin fails to disclose a method for generating a data set by modifying a comments portions of a computer program. Thus, for at least the same reasons, Martin cannot teach a computer-usable carrier medium (claim 8) or an apparatus (claim 15) configured for modifying/generating a data set by modifying/activating a link within a comments portion of a computer program. Martin simply fails to disclose the use of links within a comments portion of a computer program, or any other means by which a data set can be generated or modified in response to the modification of a comments portion of a computer program. Consequently, Martin fails to anticipate all limitations of present claims 8 and 15.

For at least the reasons set forth above, Martin does not anticipate all limitations of independent claims 1, 8, and 15. Therefore, claims 1, 8, and 15, as well as claims dependent therefrom are asserted to be patentably distinct over Martin. Accordingly, removal of this rejection is respectfully requested.

Section 103 Rejections

Claims 5, 10, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of U.S. Patent No. 6,026,233 to Shulman et al. (hereinafter "Shulman"). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01. The

cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

None of the cited art teaches or suggests a data set that can be generated or modified in response to the modification of a comments portion of a computer program. As noted above, independent claims 1 and 8 describe a method and a computer-usable carrier medium, respectively, for generating or modifying a data set in response to the modification of a comments portion of a computer program. For at least the reasons presented above in the § 102 arguments, Martin simply fails to disclose a method for generating a data set by modifying a comments portions of a computer program.

In addition to the lack of disclosure mentioned above, the teachings of Martin also fail to provide motivation for modifying a comments portion of a program to create a data set, as taught in present claims 1 and 8. For example, Martin specifically discloses, "[t]he content of the comments field is intended entirely as documentation for the programmer and hence it is ignored completely by the C++ compiler 321." (Martin, column 7, lines 45-47). Martin clearly fails to suggest a desirability for modifying a comments portion of a program to create a data set, and therefore, cannot be modified to do so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

Though Shulman is not cited for teaching any limitations of present claims 1 and 8, Applicant's assert that Shulman cannot be combined with Martin in such a manner that teaches or suggests all limitations of those claims. For example, Shulman discloses a method and apparatus for presenting and selecting options to modify a programming language statement (Shulman, Title). However, modifying programming language statements (i.e., source code), as taught by Shulman, is not equivalent to modifying a comments portion of a computer program to create a data set, as taught by the presently claimed case. Shulman does not even mention the use of a comments portion within a computer program. Furthermore, even if a comments portion was considered to be an inherent aspect of the computer program disclosed by Shulman, there would still be no motivation within the teachings of Shulman to generate a data set based on modifications made to the comments portion of the program. Consequently, Shulman provides no motivation to teach or suggest all limitations of present claims 1 and 8.

Since none of the cited art provides motivation to teach or suggest all limitations of claims 1 and 8, the cited art cannot be combined or modified to do so. As noted above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01.

For at least the reasons set forth above, none of the cited art, either separately or in combination, provides motivation to teach or suggest all limitations of present claims 1 and 8. Therefore, claims 1 and 8, as well as claims dependent therefrom, are asserted to be patentably distinct over the cited art. Accordingly, removal of this rejection is respectfully requested.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed December 8, 2003. The prior art made of record, but not relied upon, is not believed to be pertinent to the patentability of the present claims. In view of the remarks traversing rejections, Applicants assert that pending claims 1-20 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5298-05300.

Respectfully submitted,

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